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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,463	02/17/2004	Steven D. Goedeke	P-11547.00	1783

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EXAMINER	
FLORY, CHRISTOPHER A	
ART UNIT	**PAPER NUMBER**
3762	

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

E

Office Action Summary	Application No.	Applicant(s)	
	10/781,463	GOEDEKE, STEVEN D.	
	Examiner	Art Unit	
	Christopher A. Flory	3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 2/17/04
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 13 calls for the implanted medical device as previously claimed and further comprising a non-programmable non-volatile memory module. However, the independent device claim already calls for a non-programmable, non-volatile memory circuit, which would inherently contain a memory module to constitute a completely functional circuit.

2. Claim 6 is objected to because of the following informalities: claim 6 is written as being dependent from claim 4, but is clearly meant to be dependent from claim 5 in order to make the recitation of "the stabilization period" proper. Claim 6 will be examined as though dependent from claim 5. Appropriate correction is required.

3. Claims 10 and 11 are objected to because of the following informalities: claims 10 and 11 are written as being dependent from claim 8. However, the structure of the claim makes it apparent that they should be depending from independent method claim 9, and will be examined accordingly. Appropriate correction is required.

4. Claims 13-15 are objected to because of the following informalities: claims 13-15 are written as being dependent from a device claim 11. However, claim 12 is the independent device claim, and the structure of claims 13-15 clearly show that they

should depend from claim 12, and they will be examined accordingly. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 6 recites the limitation "the stabilization period" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-4 and 7-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Amely-Velez et al. (US Patent 6,535,765m hereinafter Velez'765).

Regarding claims 1-3, Velez'765 discloses a method comprising providing a first model of an implantable medical device (IMD) including a non-programmable non-volatile memory and a programmable non-volatile memory (Fig. 3, step 200; column 2, lines 42-55; column 4, lines 46-56) and providing a subsequent model derived from the

first, wherein the subsequent model excludes the programmable non-volatile memory (Fig. 3, step 204; column 1, lines 62-67; column 3, lines 2-3);

It is noted that the limitation of excluding the programmable non-volatile memory does not distinguish over the prior art. The Oxford English Dictionary defines "exclude" to mean "remove from consideration." Therefore to exclude the programmable memory can be achieved by not considering any instructions from the programmable sectors—effectively the microprocessor does not read from RAM in the subsequent model, as is the case in Velez'765 (column 7, lines 32-63). It would have been within the skill of the art to substitute the software "blanking" of the RAM memory unit with a physical removal of the programmable non-volatile memory as claimed in the current application, since they are alternate equivalents and it has generally been held to be within the skill level of the art to substitute alternate equivalent expedients.

Regarding claims 2-4, Velez'765 discloses the method as previously recited, wherein the programmable non-volatile memory comprises flash memory or EEPROM (column 9, lines 19-24) and stores operation instructions in the first model (Fig. 3, step 202) column 2, line 66 through column 3, line 5); wherein the non-programmable non-volatile memory comprises ROM (ABSTRACT; column 2, lines 52-55)

Regarding claim 7, Velez'765 discloses a detector circuit configured to detect a presence or absence of the programmable non-volatile memory (column 7, lines 6-14; column 8, lines 6-25).

Regarding claim 8, Velez'765 discloses that the non-programmable non-volatile memory in the second model stores at least one operation instruction stored in the

programmable non-volatile memory of the first model (column 7, lines 37-46; column 9, lines 34-45).

Regarding claims 9 and 10, Velez'765 discloses a method of confirming the presence or absence of programmable memory, loading an operation instruction from the programmable memory if it is present, and loading an operation instruction from a non-programmable memory if it is not (column 8, lines 6-25).

Regarding claims 11-15, Velez'765 discloses an implantable cardioverter/defibrillator including a physiologic sensor (column 6, lines 20-62; Figure 1) comprising a processor (microcontroller 60); a non-programmable, non-volatile memory circuit and module (ABSTRACT; column 2, lines 52-55); a connector element (data/address bus 96) configured to couple to a programmable non-volatile memory module (column 2, lines 42-55; column 4, lines 46-56); and a detector circuit configured to detect a presence or absence of the programmable non-volatile memory (column 7, lines 6-14; column 8, lines 6-25); wherein the programmable non-volatile memory comprises flash memory or EEPROM (column 9, lines 19-24).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Velez'765 in view of Admitted Prior Art (Admission).

Regarding claims 5-6, Velez'765 discloses the invention substantially as claimed except that the stabilization period between providing the first and second models comprises ninety days to one year. Admission teaches that the stabilization period for a typical implantable device is about ninety days to 3 three years (paragraph [23]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to establish a 90 day to one year stabilization period between programming the first model of the Velez'765 device and reprogramming (providing) the subsequent model.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Flory whose telephone number is (571) 272-6820. The examiner can normally be reached on M - F 8:30 a.m. to 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher A. Flory

George Manuel
Primary Examiner